

REMARKS

Claims 1-3, 5-20 and 23-31 are pending in the present application. Claims 1, 5, 10, 13, 18, 22, 27, 30 and 31 have been amended, and Claims 4 and 21 have been cancelled, herewith. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102, Anticipation

The Examiner rejected Claims 1-8, 13-25 and 30 under 35 U.S.C. § 102 as being anticipated by Togawa et al., U.S. Patent 5,918,008. This rejection is respectfully traversed.

The present invention is generally directed to a technique for preventing a data processing system such as a server from virus-infecting pervasive computer devices which it services. In contrast, the teachings of the cited reference are directed to preventing a virus attack to a personal computer's internal hard disk. These environments are substantially different, and have different operational characteristics and requirements, as one is operating in a networked environment where a data processing system is servicing an external device, whereas the other is process internal to a storage device. These fundamental differences will now be described in detail, including a showing that every element of the claimed invention is not identically shown in a single reference¹.

Specifically with respect to Claim 1, such claim recites a method in a data processing system for preventing exchange of viruses with a device. Thus, the device is different from the data processing system as both items are explicitly enumerated in the claim. In contrast, the cited reference teaches an internal virus protection scheme for a storage device of a personal computer (col. 1, lines 25-28 and 34-38; col. 2, lines 18-22; Fig. 8, elements 1 and 30). Applicants have amended Claim 1 to further emphasize this distinction, to expressly recite "a data processing system for preventing exchange of viruses with a device wirelessly coupled to the data processing system".

Still further, and as clearly defined per the amendment to Claim 1, the information being protected from virus attack is the actual operational code executed by the device itself. In

¹ For a prior art reference to anticipate in terms of 35 U.S.C. 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

contrast, the cited reference teaches that the items being protected from virus attack are files stored on the disk drive 30 (col. 11, lines 58-61), which are not executed by the disk drive as a part of the internal operation of the disk drive (rather, the operational code for storage device 1 is maintained in a separate ROM 31, as described at col. 10, lines 11-22, and ROM is a read-only memory that cannot be updated or synchronized). This distinction again goes to the fundamental notion that the overall operating environment of the cited reference is substantially different from the invention recited in Claim 1, where the cited reference teaches an internal virus protection scheme for a personal computer storage device, whereas Claim 1 is directed to a technique for preventing a data processing system such as a server from virus-infecting pervasive computer devices which it services. Thus, it is urged that amended Claim 1 is not anticipated by the cited reference.

Applicants traverse the rejection of Claims 2, 3 and 5-8 for reasons given above with respect to Claim 1 (of which Claims 2-8 depend upon).

Applicants traverse the rejection of Claims 13-20, 22-25 and 30 for similar reasons to those given above with respect to Claim 1.

Claims 4 and 21 have been cancelled herewith without prejudice or disclaimer.

Claims 5 and 22 have been amended to further overcome the present rejection, and emphasis the operating environment as being with respect to pervasive devices and not a stand-alone storage device of a computer.

Therefore, the rejection of Claims 1-8, 13-25 and 30 under 35 U.S.C. § 102 has been overcome.

II. 35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 9-12, 26-29 and 31 under 35 U.S.C. § 103 as being unpatentable over Togawa et al., U.S. Patent 5,918,008. This rejection is respectfully traversed.

Applicants initially urge that Claim 9 is not obvious in view of Togawa for similar reasons to those given above with respect to the missing claimed features of Claim 1 (of which Claim 9 depends upon). To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

Further with respect to Claim 9, the Examiner acknowledges that the features recited in such claim are not taught by the cited reference, but states that these claimed features are well-known. Applicants urge that whether something is 'well-known' is not a proper basis for making a rejection under 35 USC 103. As stated by the Federal Circuit, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). It is thus shown that the Examiner's assertion that the missing claimed features recited in Claim 9 are 'well-known' is an improper reason/basis for making an obviousness rejection. Thus, Claim 9 is shown to have been erroneously rejected using such 'well-known' reasoning.

Applicants further urge that there would have been no reason or other motivation to modify the teachings of the cited reference in accordance with Claim 9, for similar reasons as those discussed below with respect to Claim 10.

With respect to Claim 10, Applicants urge that because the cited reference teaches an *internal* virus protection scheme operating solely within a storage device (element 1 of Fig. 3), there is no teaching or suggestion of how such scheme might be modified to accommodate a dynamic virus protection scheme that occurs during synchronization between a data processing system and a separate device. The fact that a prior art device could be modified so as to produce the claimed device is not a basis for an obviousness rejection unless the prior art suggested the desirability of such a modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Although a device may be capable of being modified to run the way [the patent applicant's] apparatus is claimed, there must be a suggestion or motivation *in the reference* to do so. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is simply no suggestion

or other motivation per the teachings of the cited reference to extend the internal storage device virus protection scheme to encompass a technique for preventing a data processing system from virus-infecting pervasive computer devices which it services. It is thus shown that the only motivation for making such modification must be coming from Applicants' own Specification/Claims, which is improper. It is error to reconstruct the patentee's claimed invention from the prior art by using the patentee's claims as a "blueprint". When prior art references require selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight obtained from the invention itself. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). Thus, it is urged that Claim 10 has been erroneously rejected under 35 USC 103.

Applicants further show that there would have been no reason or other motivation to modify the teachings of the cited reference in accordance with the presently claimed invention, as per the teachings of the cited reference, the original information file 34 and the differential information file 35 are expressly precluded from being updated from another source outside of the storage device itself (col. 12, lines 18-25). Thus, a person of ordinary skill in the art would not have been motivated to somehow modify this internal storage device virus protection scheme to enable use in a distributed fashion, such as in an environment for preventing a data processing system from virus-infecting pervasive computer devices which it services, as the internal storage device scheme is a closed-end system that cannot co-act with other devices or processes as a part of the virus protection methodology.

Applicants further show error in the rejection of Claim 10 for similar reasons to those given above with respect to Claim 9 and the "well-known" basis of rejection, which has been expressly rejected by the Federal Circuit.

Applicants traverse the rejection of Claims 11 and 12 for reasons given above with respect to Claim 10 (of which Claims 11 and 12 depend upon).

Applicants traverse the rejection of Claim 26 for similar reasons to those given above with respect to Claim 9.

Applicants traverse the rejection of Claims 27-29 and 31 for similar reasons to those given above with respect to Claim 10.

Therefore, the rejection of Claims 9-12, 26-29 and 31 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited reference and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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